

Application No. 10/614,114
Amendment dated September 1, 2005
Response to July 19, 2005 Office communication

REMARKS/ARGUMENTS

Applicant brings to the attention of the examiner the references cited in copending application Serial No. 09/359,809 with the Information Disclosure Statement filed in this application. Examiner Toomer cited the Obayashi et al., Martineu et al., Johnson, and Takayama references in the prosecution of the copending application. Applicant cited the balance of the references in the copending application to show the state of the art of solid inorganic lubricants at the time he filed the parent application.

The amendments to the written description describe the material for decreasing friction as "a solid inorganic lubricant." Original claim 5 of the parent application (Serial No. 08/487,436 filed June 7, 1995) claims the invention as a "composition . . . wherein said material for decreasing friction comprises a solid inorganic lubricant. . ." (emphasis added) and therefore supports this amendment.

The amendments to claims 57 and 65 now describes the metal nitride material for lubricating a surface as a particulate material which the written description of the parent application, at page 17, paragraph two. The amendment further describes the lubricating material as a silicate which the written description of the parent application supports at page 14, first full paragraph and page 24 last paragraph by the recitation of the materials "asbestos," and "talc," and page 15 first full paragraph, line 3 and page 24, line 6 from the bottom by the disclosure of "mica." The amendment also characterizes the lubricating material in claims 57 and 65 as a chalcogen compound, which the written description of the parent application supports at page 17, paragraph two.

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The amendment additionally defines the claim 57 and 65 materials by describing the "silicate, . . . phthalocyanine" components as "compounds," and the material for lubricating a surface as optionally including an additional lubricant such as an "organic lubricant. . . ." The original claim language intended this meaning, but now specifies it to avoid ambiguity.

The written description of the parent application supports the phrase "mixtures thereof" included in subparagraph "(4)" of claims 57 and 65 to indicate that the invention encompasses mixtures of lubricants. Page 23, penultimate paragraph states that the invention relates to "various mixtures of each of the foregoing lubricants. . . ." whereas page 25 first paragraph notes that "mixtures of the solid or particulate lubricants (of the invention) can be used. . . ." and paragraph 2 notes that the invention also includes the use of "mixtures of the organic lubricants. . . ." Applicant also points out that the paragraph bridging pages 25 and 26 of the parent application describes "mixtures of the solid or particulate organic lubricants. . . ." comprise some of the lubricants employed according to the invention, and that the first full paragraph on page 26 further describes the lubricants of the invention as "combinations of the solid or particulate inorganic lubricant and the solid or particulate organic lubricant. . . ." Page 12, first full paragraph of the present application supports the amendment to claims 57 and 65 that now describes the phosphate of subparagraph "(2)" of these claims as an "organic phosphate."

New claim 91 sets out the various lubricating metals and alloys thereof, lubricating metal chalcogenides halides, carbonates, silicates or phosphates, or a particulate lubricating metal nitrides, or a carbon lubricants of claims 57 or 65. The written description supports this amendment at pages 15-17 and 27 inter alia.

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All amendments to the written description and the claims now included in the present application and all previous amendments to the written description and the claims in the present application, and any amendments to the written description and claims of each of the applications from which the present application depends are not intended to and do not abandon any patentable equivalents of the elements of applicant's invention, or patentable equivalents of applicant's invention as a whole, or claim of priority to any of such inventions.

The Rejection under 35 U.S.C. § 112 First Paragraph and Traverse

The examiner rejects claims 62-63 and 70-71 under 35 U.S.C. § 112, first paragraph for allegedly failing to comply with the requirement that the written description convey to a person with ordinary skill in the art that the inventor was in possession of the invention comprising the coating applied to a substrate comprising a cable or a wire at the time he filed the application. The examiner argues that the application does not describe the substrate as a cable or a wire. Applicant traverses the rejection and requests further consideration and reexamination.

As to the coated wire, or coated cable, pages 6-19 of the written description describe the various lubricants used in combination with the superabsorbent polymer which include petroleum lubricants, synthetic lubricants, grease, solid lubricants and metal working lubricants. Importantly, page 20 of the written description states that applicant's lubricant composition comprises a superabsorbent polymer in combination with lubricants described in the written description which include those described at pages 6-19.

One of the lubricants described at pages 6-19 include the lubricants noted on page 12 which comprise cable lubricants. (written description, page 12, line 6 from the bottom). The

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application therefore supports the claims directed to the lubricant of the invention on a substrate comprising a cable.

Furthermore, one of the lubricants described at pages 6-19 of the written description includes a lubricant applied to a wire substrate (page 16, line 8 from the bottom, page 17, line 5 and page 47, line 8 from the bottom). The application therefore supports claims directed to the lubricant of the invention on a substrate where the substrate comprises a wire. The examples also specifically show the composition of the present invention on a wire substrate at page 51, first full paragraph, page 52, first and second paragraphs, page 53, line 3, and page 54, first and second full paragraphs by illustrating the use of a wire whip to manufacture the compositions.

The foregoing clearly shows the superabsorbent polymer/lubricant composition coated on a cable or a wire substrate does not comprise new matter. The applicant clearly had possession of this aspect of the invention at the time he filed the application.

The Rejection under 35 U.S.C. § 103 (a) and Traverse

The examiner rejects claims 57-63, 65-71, 73, 76, and 87-90 under 35 U.S.C. § 103 (a) as unpatentable over Freeman, United States Patent No.5,218,011 in view of Marciano-Agostinelli et al., United States Patent No. 5,049,593 (Marciano-Agostinelli). Applicant traverses the rejection and requests further consideration and reexamination.

Applicant distinguishes both Freeman and Marciano-Agostinelli because the references, either taken alone or in combination with one another, neither teach nor suggest applicant's essentially water-free composition, wherein the composition comprises a

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superabsorbent polymer that absorbs greater than 100 times its weight in water in combination with a material for lubricating a surface wherein the material for lubricating a surface comprises:

(1) a lubricating metal and alloy thereof, lubricating metal oxide, halide, nitride, carbonate and phosphate, or carbon lubricant; or

(2) a silicate ester, polyphenyl ether, organic phosphate, biphenyl, phenanthrene, or phthalocyanine compound;

(3) the material for lubricating a surface optionally comprising an organic lubricant, inorganic lubricant, or a lubricant additive;

(4) or mixtures thereof.

Additionally, Freeman and Marciano-Agostinelli, either taken alone or in combination with one another neither teach nor suggest the applicant's substrate coated with the presently claimed composition, or a method for protecting a substrate from the affects of water or water migration by employing the presently claimed composition. Granted both Freeman and Marciano-Agostinelli describe water absorbent polymers, but not in combination with the materials for lubricating a surface as in the claims of the present application.

The Obviousness-Type Double patenting Rejection and Traverse

The examiner rejects the application under the judicially created doctrine of obviousness-type of double patenting over the claims of United States Patent Application Serial No. 09/779,559. The United States Patent and Trademark Office has declared Application Serial No. 09/779,559 became abandoned after the examiner issued the March 23, 2005 Office communication in this application thereby making the double patenting rejection moot.

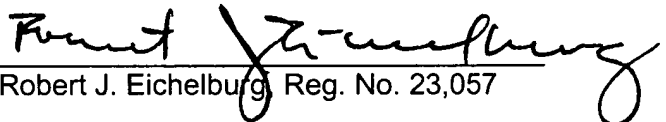
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Conclusions

Applicant requests that the examiner withdraw the rejections in view of the foregoing amendments and remarks.

Respectfully submitted,

THE LAW OFFICES OF ROBERT J. EICHELBURG

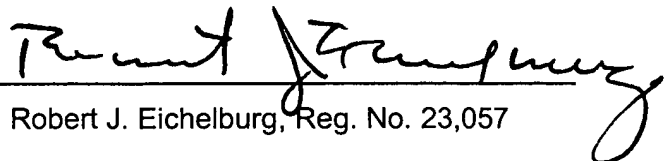
By: 
Robert J. Eichelburg, Reg. No. 23,057

September 1, 2005

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September 1, 2005

By: 
Robert J. Eichelburg, Reg. No. 23,057